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*Wilcox et al.*

*Serial No. 09/464,264*

*Amendment After Final Rejection March 31, 2005*

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## REMARKS

The foregoing amendments simply cancel claims 1-25, 43 and 44 without prejudice to applicant's right to file continuation and/or divisional applications directed to the subject matter of the cancelled claims. Claims 26-42, 45 and 46 are unchanged.

In response to Paragraph 2 of the Office Action, a copy of the International Search Report for International Application Publication No. WO 00/36560 is filed herewith.

Claims 1-46 are present in this application, and all claims stand rejected. Claims 1, 2, 6-13, 16-20, 23-27, 29, 30 and 40-46 stand rejected under 35 USC 103(a) as unpatentable over Hasegawa, U.S. Patent No. 5,055,662, in view of Drzaic et al, "A Printed and Rollable Bistable Electronic Display". This rejection is traversed. More specifically, this rejection is traversed on the grounds that all claims remaining in this application are directed to secure documents, and methods of securing documents, in which a message is disposed on a substrate and an electrophoretic medium is placed adjacent the substrate, the electrophoretic medium having first and second display states such that the message is visible when the medium is in one state but is obscured with the medium is in the other state. In effect, the electrophoretic medium is acting as an "electronic shutter" to hide or reveal the message which serves as an authentication marker for the secure document. Neither Hasegawa nor Drzaic discloses any such electronic shutter construction. Hasegawa describes a "smart card" using a conventional cholesteric liquid crystal display used to display arbitrary data (Hasegawa, column 2, line 24 and column 4, lines 10-11) and there is no suggestion that the liquid crystal display be used to hide or reveal anything behind the display itself. As the Office Action concedes, Drzaic displays only the preferred type of flexible electrophoretic medium for use in the present invention and does not disclose any use of such a medium to hide or reveal a message lying behind the medium.

The 35 USC 103(a) rejection of claims 28 and 31-39 as unpatentable over Hasegawa in view of Drzaic and Ota, U.S. Patent No. 3,668,106, is traversed for the same

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reasons as the earlier 35 USC 103(a) rejection discussed above. Ota does nothing to remedy the lack of teaching in Hasegawa and Drzaic regarding the use of an electronic shutter. With regard to the last paragraph on page 7 of the Office Action, it is respectfully noted that column 5, lines 14-15 of Ota is only discussing the need for one or two substantially clear *electrodes* in order to render the optical states of the electrophoretic medium itself visible to an observer on one or both sides of the display, and is not suggesting use of the electrophoretic medium as a shutter to hide or reveal a message located behind the medium.

For the foregoing reasons, the 35 USC 103(a) rejections are unjustified and should be withdrawn.

Reconsideration and allowance of all claims remaining in this application is respectfully requested.

Entry of this Amendment After Final Rejection is respectfully requested on the grounds that it will not require extensive review by the Examiner, being confined to supply of one document specifically requested by the Examiner, cancellation of certain claims, and a very brief response to 35 USC 103 rejections based upon references upon which the applicants have had no previous opportunity to comment.

Respectfully submitted



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## INTERNATIONAL SEARCH REPORT

Int. Appl. No.  
PCT/US 99/30212

<b>A. CLASSIFICATION OF SUBJECT MATTER</b> IPC 7 G06K19/14				
According to International Patent Classification (IPC) or to both national classification and IPC				
<b>B. FIELDS SEARCHED</b> Minimum documentation searched (classification system followed by classification symbols) IPC 7 G06K G07D G09G				
Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched				
Electronic data base consulted during the international search (name of data base and, where practical, search terms used)				
<b>C. DOCUMENTS CONSIDERED TO BE RELEVANT</b>				
Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.		
Y	GB 2 255 934 A (WILLIAMS RICHEL T GEORGE) 25 November 1992 (1992-11-25)  page 8, paragraphs 2-6; figure 1	1-6, 9, 10, 16, 18-20, 25-32, 42-46		
Y	DRZAIC P ET AL: "44.31: A PRINTED AND ROLLABLE BISTABLE ELECTRONIC DISPLAY" SID INTERNATIONAL SYMPOSIUM DIGEST OF TECHNICAL PAPERS, US, SANTA ANA, CA: SID, vol. 29, 1998, XP002127322 ISSN: 0098-966X the whole document	1-6, 9, 10, 16, 18-20, 25-32, 42-46		
-/-				
<input checked="" type="checkbox"/> Further documents are listed in the continuation of box C.				
<input checked="" type="checkbox"/> Patent family members are listed in annex.				
<b>* Special categories of cited documents:</b> <table border="0"> <tr> <td style="vertical-align: top;">           "A" document defining the general state of the art which is not considered to be of particular relevance            "E" earlier document but published on or after the international filing date            "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)            "O" document referring to an oral disclosure, use, exhibition or other means            "P" document published prior to the international filing date but later than the priority date claimed         </td> <td style="vertical-align: top;">           "I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention            "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone            "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.            "A" document member of the same patent family         </td> </tr> </table>			"A" document defining the general state of the art which is not considered to be of particular relevance "E" earlier document but published on or after the international filing date "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) "O" document referring to an oral disclosure, use, exhibition or other means "P" document published prior to the international filing date but later than the priority date claimed	"I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art. "A" document member of the same patent family
"A" document defining the general state of the art which is not considered to be of particular relevance "E" earlier document but published on or after the international filing date "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified) "O" document referring to an oral disclosure, use, exhibition or other means "P" document published prior to the international filing date but later than the priority date claimed	"I" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art. "A" document member of the same patent family			
Date of the actual completion of the international search  20 April 2000		Date of mailing of the international search report  02/05/2000		
Name and mailing address of the ISA European Patent Office, P.B. 5518 Patentlaan 2 NL - 2280 HV Rijswijk Tel. (+31-70) 340-2040, Tx. 31 651 epo nl, Fax: (+31-70) 340-3016		Authorized officer  Schauler, M		

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## INTERNATIONAL SEARCH REPORT

Int. Appl. No.  
PCT/US 99/30212

C. (Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT		
Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	CHIANG ET AL: "A stylus writable electrophoretic display device" SID INTERNATIONAL SYMPOSIUM, US, CORAL GABLES, WINNER, vol. SYMP. 10, 1979, pages 44-45-45, XP002102514 the whole document	1, 20-22, 30, 37-39
A	US 5 786 875 A (BRADER LAWRENCE ALLEN ET AL) 28 July 1998 (1998-07-28) column 3, line 24-43; figure 1	30, 33, 34, 45
A	GB 2 094 044 A (JOHNSON MATTHEY PLC) 8 September 1982 (1982-09-08) page 2, line 26-34	1, 10, 12
A	WO 98 19208 A (MASSACHUSETTS INST TECHNOLOGY) 7 May 1998 (1998-05-07) page 6, paragraph 1 page 10, line 13 -page 11, line 31 page 13, line 6 -page 14, line 27; figures 3, 4	1-46
A	COMISKEY B ET AL: "7.4L: LATE-NEWS PAPER: ELECTROPHORETIC INK: A PRINTABLE DISPLAY MATERIAL" SID INTERNATIONAL SYMPOSIUM DIGEST OF TECHNICAL PAPERS, US, SANTA ANA, SID, vol. 28, 1997, pages 75-76, XP000722661 ISSN: 0097-966X the whole document	1-46

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## INTERNATIONAL SEARCH REPORT

Information on patent family members

Int'l Application No  
PCT/US 99/30212

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
GB 2255934	A	25-11-1992	NONE	
US 5786875	A	28-07-1998	NONE	
GB 2094044	A	08-09-1982	EP 0060650 A	22-09-1982
			GB 2144250 A, B	27-02-1985
			JP 57168387 A	16-10-1982
			US 4544834 A	01-10-1985
WO 9819208	A	07-05-1998	US 5930026 A	27-07-1999
			AU 4758597 A	22-05-1998
			BR 9712377 A	31-08-1999
			EP 0937278 A	25-08-1999

Form PCT/ISA/210 (patent family annex) (July 1999)